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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Group Art Unit: 3693 )  
Serial No.: 09/966,023 )  
Examiner: Kirsten Sachwitz Apple )  
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Title: Self-Service Terminal )

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REPLY BRIEF

SUMMARY OF MAJOR POINTS OF REPLY

Point 1

In the Slater reference, an employer issues pre-paid credit cards to his employees, as payment of their salaries.

The Answer finds the claimed "rules" in Slater's payment system, because the Answer asserts that "rules" are present in that payment system.

However, Appellant's claims also recite a payment system. The claims recite "funds" in an "account," and executing "transactions" on those "funds."

Thus, the supposed "rules" in Slater correspond to rules in the payment system claimed.

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This is significant because the claims recite **additional rules**, for example, "rules governing use of funds within the financial account by the individual."

Slater does not show those **additional rules**.

Thus, the Answer is guilty of double-counting. It **CANNOT** use the "rules" in Slater's payment system to show **both**

- 1) the rules in the claimed payment system  
(ie, "funds" in an "account" and  
"transactions" thereon) and
- 2) the "rules governing use of funds within  
the financial account by the individual."

MPEP § 2131, quoted herein, requires that **each and every claim element** be shown in the reference.

#### Point 2

This Point 2 views Point 1 from a different perspective.

If the claims recited "funds" in an "account" and "transactions" on those "funds," **and nothing more**, then the supposed "rules" in Slater would seem to be correspond to that recitation.

That is, the Answer asserts that rules in Slater govern the handling of pre-paid credit cards, so that Slater shows "rules." If so, then by the same reasoning, analogous rules govern the handling of the "account" in Appellant's claims.

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Thus, the claimed "funds" in "accounts" etc., with their associated rules, by the Answer's own reasoning, would correspond to the supposed rules in Slater's payment system.

However, the claims recite **additional rules**, namely, "rules governing use of funds within the financial account by the individual."

Slater's **single element** cannot be used to show two different claim recitations.

### Point 3

As stated above, the Answer asserts that rules govern the handling of the pre-paid credit cards in Slater, so that Slater shows "rules." However, those supposed "rules" are imposed on the parties handling the money in Slater, such as the bank.

The claims recite "rules governing use of funds within the financial account **by the individual**." To repeat, the claims recite "rules governing use of funds . . . **by the individual**."

Under the claims, the "individual" is "under the supervision of the organization." The "organization" makes the "rules."

Slater's supposed "rules" do not correspond to these recitations.

-- Slater's rules apply to the bank holding the money. The claim states that the "rules" apply to the "individual."

-- The claim states that the "rules" govern "use" of the "funds" by the "individual." There is no restriction in Slater on how the employee uses money obtained from the pre-paid credit card.

-- The claim states that the "individual" is under "supervision" of the "organization." The latter makes the "rules" covering use of "funds" by the "individual."

In Slater, there is no corresponding "individual" nor "supervision" nor "organization" nor "organization" which makes "rules" for an "individual." Slater's rules (if any) apply to the bank holding the money.

#### Point 4

The claims state that the "transaction" occurs at an SST "on premises" of the "organization."

As stated above, the "organization" makes the "rules" covering use of "funds" by the "individual."

No such SST in Slater has been shown. No SST on "premises" of the "organization" which makes "rules" covering use of "funds" by the "individual" has been shown in Slater.

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Slater shows an ATM which pays money to a holder of a pre-paid credit card. Slater expressly states that withdrawal of the money can be done anywhere. (Column 4, lines 6 - 11; column 2, lines 32 - 37.)

#### Comment

Not all points made in this Summary are elaborated below. Some are considered self-explanatory.

Some additional, points are made below, each of which, by itself, is effective to rebut the rejections.

#### REPLY

##### Reply to Answer, Pages 1 - 6

No reply needed.

##### Reply to Answer, Page 6, Section 10 (Re: "Rules" Supposedly Found in Slater)

##### Point 1

The Answer is raising a new ground of rejection. This Point 1 will explain the new ground of rejection.

Explanation of the new ground requires a brief review of claim recitations.

Claim 1 states that

-- an "organization" establishes "rules

governing use of funds within the financial account by the individual."

-- when the individual seeks a "transaction," the invention examines the "rules," and executes the "transaction" if the "transaction" is consistent with the "rules."

For example, the Brief states on page 12:

. . . if the requested transaction relates to a payment for lunch, the rules may allow the transaction between 11:00 am and 1:00 pm, but not at other times.

Thus, THE SAME RULES WHICH WERE "ESTABLISHED" ARE THE RULES WHICH ARE "EXAMINED" BY THE INVENTION. But in Slater, as applied in the Final Rejection, TWO DIFFERENT SETS OF RULES were being applied.

The Brief pointed this out: the claims recite a **single set** of "rules," which are both **ESTABLISHED** and then **EXAMINED**. The "rules" in Slater which are **established** are **different** from the "rules" which are **examined**.

The Answer apparently agrees with this conclusion. The Answer, now relies on a **different element in Slater** to show the claimed "rules."

That is a new ground of rejection.

The new ground is that Slater shows a payment system in which

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an employer gives pre-paid credit cards to his employees, as payment for their salaries. The Answer asserts that "rules" apply to that payment system, and thus the claimed "rules" are found in Slater.

### Point 2

The new ground is invalid for a first reason.

The new ground uses the supposed "rules" in Slater (which govern payment of pre-paid credit cards) to show **TWO** claim recitations. Double-counting is not allowed.

MPEP § 2131 states:

A claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Claim 1, like Slater, recites a type of payment system. Claim 1 states that "funds" are contained within an "account." Appellant points out that the word "account" is based on the root-word "count." An "account" keeps track of (or "counts") money.

If "funds" are in an "account," that means that rules are followed regarding the storage and disbursement of the funds, and so on.

Thus, the claims recite a payment system. Under the Answer's own logic, a payment system requires "rules."

According to the Answer, the payment system of Slater contains "rules." By the same reasoning then, the **claimed** payment system shows similar "rules" as in Slater.

The supposed "rules" in Slater correspond to the procedures followed in the claimed "account" holding "funds," and the related "transactions."

The supposed "rules" in Slater cannot also be used to show something else in the claims.

Stated more simply: the claims recite two sets of rules.

-- The first set is found in the recitation of a payment system: an "account" is recited, which holds "funds," and "transactions" occur with respect to the "account." Those recitations refer to a standard set of accounting procedures, or "rules," in the Answer's parlance.

-- The second set of claimed rules is in "rules governing use of funds within the financial account by the individual."

The supposed "rules" in Slater's payment system cannot be used to show **BOTH** the first and second set of rules in the claims.

### Point 3

Point 2 can be viewed from a different perspective.



Slater shows a payment system.

The claims recite a payment system, plus additional "rules."

The Answer relies on rules supposedly inherent in Slater's payment system to show the claimed additional "rules."

But those supposed rules in Slater simply correspond to analogous rules in the claimed payment system. Those supposed rules in Slater cannot be used to show other claim elements, namely, the additional rules.

#### Point 4

The new ground of rejection is invalid for a second reason. The claimed "rules" "[govern] use of funds within the financial account by the individual."

The supposed "rules" in Slater do not do that.

Those rules control the party holding money in Slater. That is not the claimed "individual."

The claimed "individual" is "under the supervision of the organization." (Such as a student, the "individual," under "supervision" of a school, the "organization.")

Further, Appellant submits that the Answer's assertion is specious. Under the Answer's reasoning, the bank in Slater which disburses money to the pre-paid credit card holders makes "rules."

Appellant asks: "To whom do those "rules" apply ?" Plainly, the "rules" apply to the bank. Consequently, no "rules" exist in

actuality. If the bank makes rules which apply to itself, then the bank can make contrary rules, or abrogate the initial rules.

From another point of view: who enforces the "rules" ? Nobody. If no enforcement exists, then no true "rules" exist.

Under the Answer's reading of Slater, no true "rules" exist.

#### Point 5

The new ground of rejection is invalid for a third reason.

The Answer, page 7, top, asserts that the supposed "rules" in Slater place a limit on the amount of money which is disbursed to a holder of a pre-paid credit card.

Appellant points out that this is another example of double-counting.

The claim recites "funds" in an "account." That plainly means that a rule is applied, which limits withdrawals to the amount of "funds" present. This is common sense.

Thus, the supposed limit-rule in Slater is found in the claim recitation of "funds" in an "account."

That limit-rule cannot also be used to show the claimed "rules governing use of funds . . ."

Slater's supposed limit-rule is being used to show two claim recitations. One recitation is of "funds" in an "account" etc. That plainly sets out a rule that nothing in excess of the "funds" can be withdrawn. The other recitation is "rules governing use of

funds within the financial account by the individual."

The limit-rule in Slater cannot be used to show both.

Point 6

The new ground of rejection is invalid for a fourth reason.

The Answer, page 7, top, asserts that the supposed "rules" in Slater place a limit on the amount of money which is disbursed to a holder of a pre-paid credit card. The elements in Slater cited to show this are the following:

- 1) Figure 1, item 16;
- 2) Column 3, lines 8 - 15; and
- 3) Figure 1, item 22.

However, element (1), above, is a block in a flow chart, which states "Implementation Specialists Assists (sic) in Implementing Selected Application."

Element (2) above explains element (1), and states:

An implementation specialist may assist in implementing a selected application or applications at step 16.

Implementation of a selected application or applications may include

ensuring that applicable governmental regulations are properly followed,

providing interface access between the appropriate mechanisms of a sponsor and the appropriate mechanisms of the issuer, and

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ensuring that a sponsor has the appropriate hardware and software to enable interaction with an issuer.

Other implementation may also be required.

(Slater reference, column 3, lines 8 - 15.)

Element (3) is another block in the flow chart, which states "Issuer Fund Account as Directed." ("Fund" should probably be the verb "Funds.")

Appellant will address these Elements in reverse-order.

Element (3) means that money is placed into an account to allow the employees to draw on it, through their pre-paid credit cards. ("Sponsor" is the employer: column 2, lines 21 - 23. "Issuer" is the bank issuing the pre-paid credit card: column 3, lines 22 - 25.)

Element (3) merely refers to the event wherein the bank puts money into an account. Placing money into an account does not show "establish[ing] rules governing use of funds within the financial account by the individual," as claimed.

Elements (1) and (2) show nothing related to placing a limit on the amount of cash to be withdrawn. These elements merely refer to processes undertaken by Slater to make his system work.

The claimed "rules" and "establishing" them are not shown by the elements in Slater cited by the Answer.

Point 7

Point 6 shows that Slater shows no actual "rules" as claimed. This Point 7 shows that no such "rules" are implied in Slater.

Slater, column 2, discusses placing "funds" into an "account" associated with each employee's pre-paid credit card.

It could be argued that this implies a limit on funds available to the pre-paid credit card.

If so, then the same argument applies to the claim recitation of "funds" in an "account."

Therefore, if Slater shows a limit (or "rule") by this argument, then the same argument shows the same limit/rule in the claimed "funds" in an "account."

Restated: this argument merely shows that Slater shows an element similar to a claim element, namely, a payment system involving an "account," with limits.

Under the rules of claim interpretation, the payment system in Slater cannot be used to show additional claim elements in the claims. The payment system in Slater, together with implied characteristics (such as rules/limits) has already been used to show the claimed payment system, with its implied characteristics.

Specifically, the limit (or rule) in Slater's payment system cannot then be used for a second purpose, namely, to show the claimed "rules governing use of funds . . ." That is double-counting.

In addition, as explained herein, even if NO double-counting is occurring, the limit-rule supposedly found in Slater does not correspond to the claimed "rules" identified in the preceding sentence.

Point 8

As Points 6 and 7 indicated, the supposed limit on withdrawal of funds is not actually shown in Slater, but, if present at all, that limit is implied, or inherent.

MPEP § 2112 states:

EXAMINER MUST PROVIDE RATIONALE OR EVIDENCE  
TENDING TO SHOW INHERENCY.

In relying upon the theory of inherency, the examiner must provide a **basis in fact and/or technical reasoning** to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art.

The Answer has provided no "basis in fact and/or technical reasoning" showing why the "limit" of the Answer, page 7, lines 1 - 3, is found in Slater. (The Answer uses the words "an amount of cash to be available [to] the cardholder." Appellant treats that as a "limit" for simplicity.)

Appellant submits that this is not a trivial issue. An overall reading of Slater indicates to the undersigned attorney that the employer in Slater gives his employees credit cards.

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However, employees cannot make deposits to the cards. (Column 2, lines 15, 16.) But Slater states:

Nonetheless, the characteristics and parameters of the stored value card are equally applicable to other cards and card accounts.

(Column 2, lines 16 - 18.)

This passage seems to indicate that the stored value cards are just like credit cards. Thus, employees can get "credit" on their cards. For example, an employee can over-draw on his account on Thursday. Then on Friday (payday), part of his salary is allocated to cover the over-draft. The balance is deposited into the account as usual.

This would cost the employer nothing, because the bank covers the over-draft.

Therefore, Appellant submits that the supposed limit discussed at the top of page 7 of the Answer has not been shown to be implied by Slater, as required by the MPEP section on Inherency, cited above.

Consequently, the supposed "rules" in Slater, relied on by the Answer, have not been shown in Slater, either actually or by implication. As a result, the new ground of rejection must fail.

Point 9

Claim 1 recites two accounts: one for the "individual" and one for the "organization." For example, if the "individual" wishes to buy lunch, money is transferred from the former account to the latter.

Those two accounts have not been shown in Slater.

Point 10

The Answer, page 7, asserts that the claims merely recite an ordinary credit card transaction.

The Brief, and this Reply, rebut such assertions: numerous claim recitations are not found in Slater.

Further, this part of the Answer reduces the invention to a "gist," namely, that (1) rules are applied at a credit card transaction, and (2) those rules show the invention. Stated more simply: the Answer asserts that the rules governing credit card transactions generally show the invention.

MPEP § 2141.02, second heading, states:

Distilling the Invention down to a "Gist" or  
"Thrust" . . . disregards "as a whole"  
requirement.

As this MPEP section indicates, all claim recitations must be considered. The Answer's assertion that a generic credit card transaction shows the invention fails to comply with this MPEP



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section.

Further still, as explained above, the claims recite two types of rules. One is the rules indicated by "funds" in "accounts." The other is the "rules governing use of funds . . ." Slater fails to show both types of rules.

Point 11

The claims recite "rules," which are plural in number.

Even if the Answer's interpretation of Slater be correct, the Answer has merely shown a **single** rule, namely, a limit on withdrawals. That does not correspond to the plural rules recited.

Point 12

The claims recite "rules governing use of funds within the financial account by the individual."

The "rules" in Slater upon which the Answer relies is a rule which supposedly limits amounts of withdrawal.

That does not correspond to the claimed "rules." The party withdrawing money in Slater can still use the money for whatever purposes the party wishes. There is no "[rule] governing use of funds . . . by the individual," as claimed.

Point 13

The comments on claim 1, above, apply to the other independent

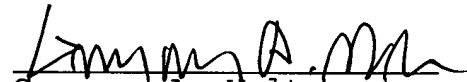
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claims.

#### CONCLUSION

Appellant requests that the Board overturn all rejections, and pass all claims to issue.

Respectfully submitted,



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